



2165

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Dr. Al J. Mooney

Serial No.: 9/492398

Filed: January 27, 2000

For: **Method of Supplying and Dispensing
Prescribed Medical Supplies Through a Web
Site Associated with a Medical Care Provider**

Patent Pending

Examiner: Samuel G. Rimell

Group Art Unit: 2165

Attorney's Docket No: 4333-003

Raleigh, North Carolina
May 19, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 19, 2005.

Kathy L. Stehle
Kathy L. Stehle

REQUEST TO ENTER EVIDENCE AFTER THE FILING OF AN APPEAL BRIEF

Sir:

Applicant respectfully submits the following Exhibits labeled "Exhibit 1" and "Exhibit 2" for entry into the record and for consideration by the Board. The Exhibits are being submitted under separate cover pursuant to 37 C.F.R. § 1.195. No fees should be required for entry of these Exhibits. However, if any fees are required, the Commissioner is hereby authorized to charge them to Deposit Account 18-1167.

REMARKS

Applicant filed an Appeal Brief on April 29, 2004, in response to a final rejection of the claims under 35 U.S.C. §102 over Silver (U.S. Patent No. 6,269,339). The Brief as-filed included two Exhibits labeled Exhibit 1 and Exhibit 2. Applicant subsequently received a Communication from the Office mailed April 20, 2005, requiring the removal of the Exhibits and resubmission of a corrected Appeal Brief. Applicant has complied with the Communication and now respectfully requests the Examiner enter the Exhibits into the record for consideration by the Board. The Exhibits do not constitute new matter. Nor do they require an additional search or place a burden on the Examiner. Rather, entry and consideration of the Exhibits will allow the Board to properly interpret the claim language and as such, expedite resolution of the case.

Specifically, "Exhibit 1" is a printout from Dictionary.com that defines the term "medical examination." Dictionary.com, *entry for the term 'medical examination,'* Source: WordNet ® 1.6, © 1997 Princeton University, <http://dictionary.reference.com/search?q=medical%20examination>. The term "medical examination" is in the claims being appealed, and its interpretation has been a point of disagreement between Applicant and the Office. Throughout prosecution, the Examiner has maintained that the computerized questionnaire disclosed in the Silver reference equates to the claimed "medical examination." Applicant has repeatedly countered this contention with the fact that a medical examination is a physical examination performed by a licensed medical care provider. Applicant's definition is one that is commonly understood by those skilled in the art and is supported by the specification. Further, it is one that Exhibit 1 explicitly supports.

Exhibit 2 is a printout of the North Carolina Medical Board web page. The North Carolina Medical Board Web Page, *Position Statement on Contact with Patients Before Prescribing*, adopted November 1999, February 2001, <http://www.ncmedboard.org/contact.htm>. This exhibit clarifies which entities are able to "prescribe" (i.e., write a prescription) as that term is used in the claims being appealed. The Examiner maintains that the computer of Silver

“prescribes” medical items and devices in response to user-provided answers to the questionnaire. Applicant maintains that the “suggestions” offered by the computer (e.g., stop smoking, exercise, take vitamins) do not constitute a “prescription.” Instead, they are common sense suggestions that do not require a medical examination. No one skilled in the art would ever understand the computerized suggestions of Silver to be the claimed prescriptions. Applicant has maintained throughout prosecution that only a medical care provider can provide a prescription, and only after conducting a medical examination on the individual. Indeed, Exhibit 2 explicitly supports this interpretation. Particularly, the third paragraph of Exhibit 2 prohibits prescriptions to individuals based solely on answers to a set of questions – which is exactly the type of system that Silver discloses.

Applicant fully appreciates that these *specific* exhibits have not been *physically* presented to the Examiner during the course of prosecution. However, the Exhibits were only found at the time the original Brief was being prepared. Applicant believed in good faith during prosecution that the common understanding of what a “medical examination” is, and who could “prescribe” a medical supply, would prevail, especially in light of Applicant’s specification and explicit statements. Indeed, it cannot be said that these same issues have not been addressed and discussed at length throughout prosecution. The Examiner’s consistent refusal to interpret the claim language using the plain and ordinary meanings of the terms – *as required by the law* – now necessitates entry of the exhibits to aid claim interpretation. The Exhibits are relevant to and probative of the issues under consideration at the Board. Particularly, they affect claim construction, and claim construction is fundamental to a determination of patentability. Entry of the Exhibits would not be prejudicial, but rather, would only serve to further the interests of the Office, Applicant, and the public-at-large by allowing the claims to be properly construed.

The Exhibits should be entered and considered concurrently with the corrected Brief. They will expedite resolution of the case without placing any additional burden on the Examiner.

Accordingly, Applicant respectfully requests the entry of Exhibits 1 and 2 for consideration by the Examiner and the Board.

By:

Respectfully submitted,

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